



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/876,408	06/07/2001	Charles P. Brown	00,464-A	7316

32097 7590 02/02/2009
LESAVICH HIGH-TECH LAW GROUP, P.C.
SUITE 325
39 S. LASALLE STREET
CHICAGO, IL 60603

EXAMINER

NGUYEN, TAN D

ART UNIT	PAPER NUMBER
----------	--------------

3689

MAIL DATE	DELIVERY MODE
-----------	---------------

02/02/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/876,408	BROWN, CHARLES P.	
	Examiner	Art Unit	
	Tan Dean D. Nguyen	3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/ are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. In view of the Appeal Brief filed on 11/8/2007, Reply Brief of 3/31/08 and subsequent interviews with the attorney, PROSECUTION IS HEREBY REOPENED.

The rejection is set forth below.

Claim Status

2. Claims 1-33 are pending and rejected as below. They comprise of 5 set of claims:

- 1) Method claims: 1-13;
- 2) Method claims: 14-18;
- 3) Method claims: 19-24;
- 4) Method claims: 25-29;
- 5) System claims: 30-31, and
- 6) System claims: 32-33.

System claims 30-31 (broadest) and 32-33 (broader) and will be examined first followed by the method claims.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Method claims 1-13, 14-18, and 19-24 are rejected under 35 U.S.C. 101 because in order for a method to be considered a "process" under §101, a claimed process must either:

- (1) be tied to another statutory class (such as a particular apparatus) or

Art Unit: 3689

(2) transform underlying subject matter (such as an article or materials) to a different state or thing.

See at least (1) *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); (2) *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); (3) *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972) and (4) *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)). A method claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here claims 1-13, 14-18, and 19-24 fail to meet the above requirements since there is (1) not a sufficient tie to another statutory class or (2) transform underlying subject matter (such as an article or materials) to a different state or thing.

5. Claims 2, 15, 20 and 26 are rejected under 35 USC 101 since the claimed invention is directed to more than one statutory category. 35 USC 101 clearly states that:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The independent Claims 1, 14, 19 and 25 begin by discussing a method and the body of each claim discusses the steps, however dependent claims 2, 15, 20 and 26 respectively use language that is used in the claims of a product. "A computer readable medium having". A claim of this type is precluded by the express language of 35 USC 101 which is drafted so as to set forth the statutory classes of invention in the alternative only", Ex parte Lyell (17 USPQ2d 1548).

Claim Objections

6. Claims 2, 15, 20 and 26 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The previous claims are method claims, and inclusion an item such as "a computer readable medium" does not further limit does not further limits the scope of "protecting domain name registrations ..." and steps of "accepting information ...", "accepting ..." and "issuing a permanent registration ...". Claims 2, 15, 20 and 26 appear to be independent product claims (computer readable and storage medium) containing instructions for causing a processor to execute the steps similar to claim 1 and should be standing as separate independent claims.

Claim Rejections - 35 USC § 112

7. Claims 1-13, 19-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1) In claim 1, the phrase "perpetually" in "perpetually pay all future renewal fees" and "perpetually determining, paying and verifying current and future renewal fees" is vague and indefinite because the term "perpetually" normally means "lasting or enduring

Art Unit: 3689

or continuing forever or for an indefinitely long time or eternally" and the specification fails to define (or is unclear) how long it will go on.

2) Similarly, claims 10, 14, 19, 20, 24, 25, 30, 32 which have the term "perpetually" are rejected for the same reasons set forth above.

3) In claim 1, line 5, the 2nd step of "accepting a one-time permanent registration fee" is vague and indefinite since fee normally refers to the cost of a service or product. From the specification, it appears this phrase appears to mean "accepting a one-time permanent registration fee payment" and therefore, insertion of the term "payment" after "fee" is recommended to improve clarity.

4) Similarly, claims 10-12 and 21-22, which are related to the term "fee" are rejected for the same reason above.

5) Similarly, claims 19-24, are rejected for the same reasons set forth in claims 1-13 above.

6) Claims 2, 15, 20 and 26 are indefinite because they are hybrid claims, claiming both method comprising a plurality of steps and an article (product) (computer readable medium) for causing a processor to execute the steps of the method. The claims are vague and indefinite because it did not "apprise a person of ordinary skill in the art of its scope".

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 3689

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 30-31 and 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over BURSTEIN ET AL in view of Domain Name Registration.com and/or further in view of

Independent system claim 30 is as followed:

30. A permanent domain name registration system, comprising
in combination:

a) a permanent registration certificate for providing permanent registration of a domain name, wherein the permanent registration certificate provides a permanent registration of a domain name including perpetually determining, paying and verifying current and future renewal fees for the domain name at a public domain name registrar; and

(b) a plurality of servers associated with a plurality of databases accessible via the Internet for accepting information associated with a domain name registration obtained at the public domain name registrar, accepting a one-time permanent

Art Unit: 3689

registration fee for the permanent registration certificate and for issuing the permanent registration certificate.

Note: for convenience, letters (a)-(b) are added to the beginning of each step.

11. Note: that independent claim 30 is an apparatus claim. In examination of the apparatus claim, the claims must be structurally distinguishable from the prior art. While features of an apparatus claim may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See MPEP 2114. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). Apparatus claims cover what a device is, not what a device does. *Hewlett-Packard Co. vs. Bausch & Lomb Inc.* (Fed. Circ. 1990). Manner of operating the device or elements of the device, i.e. recitation with respect to the manner in which a claimed apparatus is intended to be employed/used, does not differentiate apparatus from the prior art apparatus. *Ex parte Masham*, 2 USPQ2d 1647 (BPAI, 1987). Also, this is an apparatus claim and intended use limitation for the system/device or apparatus, i.e. "for providing" carries no patentable weight. Therefore, in claim 30 above, the following phrases carry no patentable weight:

1) In (a), the phrase "for providing permanent registration of a domain name" (intended use of the "certificate")

2) In (a), the phrase "provides a permanent registration of a domain name including perpetually determining, paying and verifying current and future renewal fees for the domain name at a public domain name registrar" (manner of operating an item/tool of the device ("a certificate")).

Art Unit: 3689

3) In (b), the phrase "for accepting information associated with a domain name registration obtained at the public domain name registrar, accepting a one-time permanent registration fee for the permanent registration certificate and for issuing the permanent registration certificate" (intended use of "plurality of servers").

In a similar domain name management system, **BURSTEIN ET AL** discloses:

a) registering function for providing registration of a domain name;

{see Figs. 1, 2, 6-7, col. 4, line 35}

and

(b) a plurality of servers associated with a plurality of databases accessible via the Internet for accepting information associated with a domain name registration

{see Fig. 1a, Server 100, server 102, server 118, 120, server 110, server 114, database 106, col. 5, lines 5-35, col. 6, lines 15-65, col. 7, lines 1-45}}.

BURSTEIN ET AL fairly teaches claim 30 except for a feature in (a), a certificate (receipt) for confirming or verifying the registration which is well known act or feature. Note that on col. 2, lines 45-50, BURSTEIN ET AL discloses that "...*domain name for web hosting and email....incorporate one or more domain names into an organizational identity or business. As such, use a particular domain name can be viewed as a **significant asset** ...*".

As indicate above, "certificate" is merely an item or tool or a paper with information or data records including content plain textual information or graphics, etc., that functions as a "certificate" for "permanent registration" which normally do not receive any patentable weight in an apparatus claim or method claim.

12. **Examiner's Note:** The examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In a similar domain name management system, **Domain Name Registration .com** is cited to teach the feature of providing a certificate (a copy of the confirmation) for providing registration of a domain name for a permanent period (two years) with a one-time payment fee and no monthly charges and with payment options for paying online using secure server. The copy indicates that the domain name registration step is approved and registered and that "*your new domain name will be set up to access a Temporary page on the Web like this*". {see pages 1-2}. It would have been obvious to modify the teachings of BURSTEIN ET AL by providing a certificate as taught by Domain Name Registration.com for the purpose of indicating that the domain name registration step is approved and registered and ready for use.

As for the limitation of "a permanent registration" on the certificate, this has no patentable weight in an apparatus claim.

Alternatively, in another similar registration/subscription service, KORITZINSKY et al discloses several types of fee payment options (financial management arrangements) that may be provided to the subscriber for different levels of service, such as (a) pay-per-use, (b) periodically (yearly), or (c.) permanently, such as lifetime or

Art Unit: 3689

non-expiring warranty service {see col. 21, lines 15-50}. In view of the teaching "use a domain name as a significant asset for certain companies/registrants" as taught by BURSTEIN ET AL above, it would have been obvious to a skilled artisan to modify the registration system of SCHNEIDER by including permanently registration of service, such as lifetime or non-expiring warranty service as taught by KORITZINSKY ET AL as shown on col. 21, lines 15-50 for the inherent benefits of lifetime or non-expiring warranty service since it's a significant asset for the registrant/company.

As for dep. claim 31 (part of 30) which deal with a plurality of servers and its associated database, these are taught in BURSTEIN ET AL/Domain Name Registration.com as shown on BURSTEIN ET AL Figs. 1, col. 5, lines 1-35, col. 6, lines 15-67 "... *a number of servers configured* ...", and Domain Name Registration.com page 2, "Payment Options **Server** ... and page 3 "...**DOMAIN NAME SERVERS**...". Therefore, it appears that these functions are inherently included in the teachings of BURSTEIN ET AL /Domain Name Registration.com and/or KORITZINSKY et al. Moreover, the function or intended use of the apparatus/server, i.e. "purchase/payment", this is mere intended use of the server and has no patentable weight indicated above.

As for independent system claim 32, which has the limitation of claim 30 and further include a website associated with the registration, it's rejected over the rejection of claim 30 as cited above and further in view the teaching of the website associated with the registration as mentioned in BURSTEIN ET AL /Domain Name Registration.com or KORITZINSKY et al as cited above.

Art Unit: 3689

As for dep. claim 33 (part of 32) which has similar features as in dep. claim 31 (part of 30), it's rejected for the same reason set forth in the rejection of dep. claim 31 above.

13. Claims 1-3, 9, 12-13, 14-18, 19-20, 22-24, and 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over BURSTEIN et al in view of Domain Name Registration.com and KORITZINSKY et al.

Claim 1 is as followed:

1. A method for protecting domain name registrations with a permanent registration certificate, comprising:

a) accepting information associated with a domain name registration obtained from a public domain name registrar on a permanent domain name registration system;

b) accepting a one-time permanent registration fee for the domain name registration on the permanent domain name registration system, wherein the one-time permanent registration fee is used to perpetually pay all future renewal fees for the domain name registration; and

(c) issuing a permanent registration certificate for the domain name registration based on the accepted information, wherein the permanent registration certificate provides a permanent registration of the domain name registration including perpetually determining, paying and verifying current and future renewal fees due for the domain name registration at the public domain name registrar from the permanent domain name registration system.

Note: for convenience, letters (a)-(c) are added to the beginning of each step.

1) Note also, it appears that this is a data processing system. In step (a), the phrase after “information” of “associated with a domain name registration obtained from a public domain name registrar on a permanent domain name registration system”, they are considered as non-functional descriptive material (NFDM) on the “information”, thus having no patentable weight. The mere insertion of “domain name” data over “data” does not “impart functionality when employed as a computer component”, thus having no patentable weight.

See MPEP 2106.01 “Descriptive material can be characterized as either “functional descriptive material” or “nonfunctional descriptive material.” In this context, “functional descriptive material” consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of “data structure” is “a physical or logical relationship among data elements, designed to support specific data manipulation functions.” The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) “Nonfunctional descriptive material” includes but is not limited to music, literary works, and a compilation or mere arrangement of data.

Also, the source of the “data” or “information” does not further adds limitation to the data/information and maybe considered as non-functional descriptive material.

2) Similarly, in step (c), the phrase after “certificate” of “provides a permanent registration of the domain name registration including perpetually determining, paying and verifying current and future renewal fees due for the domain name registration at

Art Unit: 3689

the public domain name registrar from the permanent domain name registration system”, they are considered as non-functional descriptive material (NFDM) on the “information/certificate”, thus having no patentable weight. The mere insertion of “conditions” data over “information/certificate” does not “impart functionality when employed as a computer component”, thus having no patentable weight.

3) Note: In claim 1, step (b), as for the phrase after “registration fee” of “is used to perpetually pay all future renewal fees for the domain name registration”, it is not a positively recited method step but, rather, is mere intended use of the fee and thus having no patentable weight. See MPEP 2173.05 (q), 2106, and 2111.04, which indicate that a method claim requires active, positive steps.

In a similar method for managing domain name registration, **BURSTEIN et al** discloses the steps of:

a) accepting information (communicating with the domain name registration “DNS”) [associated with a domain name registration obtained from a public domain name registrar on a permanent domain name registration system];

{see Fig. 1, element 100, element 102 “Back End Domain Manager”, “DNS”, col. 2, lines 12-67, cols. 5-6, 7-8}}

b) accepting a registration fee for the domain name registration on the domain name registration system, wherein the registration fee [is used to perpetually pay all future renewal fees for the domain name registration]; and

Art Unit: 3689

{see col. 2, lines 40 "...has registered a domain name, paid the associated fees..."}

(c) issuing a registration certificate (or receipt) for the domain name registration based on the accepted information, wherein the registration certificate [provides a permanent registration of the domain name registration including perpetually determining, paying and verifying current and future renewal fees due for the domain name registration at the public domain name registrar from the permanent domain name registration system].

{see Fig. 1, inherently included in the system of BURSTEIN et al for customer's verification or confirmation of a official/valid registration or request, see general teaching of "confirmation of a request" on col. 14, lines 45-47 "... *sending a confirmation message...*". Note also that issuing a receipt or certificate to confirm a task or transaction is a well known confirmation/verifying task or tool and would have been obvious to a skilled artisan.}

Note on col. 2, lines 40-50, BURSTEIN et al discloses that domain name service (web hosting and e-mail) is for use for a specific period of time (well known 1 year subscription period or yearly subscription service of \$35/yr) and the domain name represents the "business" so "it can be viewed as a significant asset for certain registrants".

Art Unit: 3689

BURSTEIN et al fairly teaches the claimed invention except for the type of fee payment in step (b), i.e. "a one-time permanent registration fee" payment and subsequent feature of "permanent registration certificate" on step (c).

In a similar domain name management system, **Domain Name Registration .com** is cited to teach the feature of providing a certificate (a copy of the confirmation) for providing registration of a domain name for a permanent period (two years) with a one-time payment fee and no monthly charges and with payment options for paying online using secure server. The copy indicates that the domain name registration step is approved and registered and that "*your new domain name will be set up to access a Temporary page on the Web like this*". {see pages 1-2}. It would have been obvious to modify the teachings of BURSTEIN ET AL by providing a certificate as taught by Domain Name Registration.com for the purpose of indicating that the domain name registration step is approved and registered and ready for use.

In another subscription service, **KORITZINSKY et al** discloses several types of fee payment options (financial management arrangements) that may be provided to the subscriber for different levels of service, such as (a) pay-per-use, (b) periodically (yearly), or (c.) permanently, such as lifetime or non-expiring warranty service {see col. 21, lines 15-50}. In view of the general problems with respect to the expired subscribed service for the domain name registration and the significant impact of the domain name for many businesses "a significant asset", it would have been obvious to modify the yearly/annual fee payment teachings of BURSTEIN et al/Domain Name Registration.com with a permanent fee payment as taught by KORITZINSKY et al to

Art Unit: 3689

obtain the benefit of lifetime or non-expiring warranty service, thus protecting the “a significant asset” for life/permanently if desired.

Note that the type of subscription service in KORITZINSKY et al deals with subscribing to diagnostic system/service, however, the type of service or subscription service is not critical since fee payment arrangement can be applied in any subscription service. Moreover, the critical issue is “fee payment option” and facing with the problem of expiring of service due to non-payment, a skilled artisan would look to the teachings of fee payment options or different levels of service and if the service is so critical while the fee payment is so cheap, one would pick the permanent or lifetime or non-expiring warranty service to insure lifetime service. As for the difference in the type of subscription services, again, this is not critical and within the skill of the artisan since the major issue is the types of fee payment options for different levels of service. As for the limitation of “wherein the one-time permanent registration fee is used to perpetually pay all future renewal fees for the domain name registration”, this reads over the limitation “lifetime or non-expiring warranty service” of KORITZINSKY et al and is therefore inherently included in the teachings of KORITZINSKY et al above.

Also, KORITZINSKY et al teaches the well known task of issuing a receipt or certificate of the service request and would have been obvious to use it in the domain name registration task of BURSTEIN et al, see col. 21, lines 24-26 “receipt of the service request”. As for the limitation “a permanent registration certificate”, this is taught in BURSTEIN et al / KORITZINSKY et al when “life time” service is selected/requested

Art Unit: 3689

and the receipt of the service requested would inherently include the "permanent service".

As for dep. claim 2 (part of 1 above), as well claims 15, 20 and 26, which deal with well known computer readable medium having stored therein instructions for causing a processor to execute the steps of method claim 1, this is inherently included in the online system of BURSTEIN et al /KORITZINSKY et al.

As for dep. claim 3 (part of 1 above), which deals with well known digital data processing management system, i.e. creating an electronic item (certificate) and store the item in the databases, this is fairly taught in Figs. 1-2, cols. 5-6 which indicates 3 functions, registering, maintaining, modifying and updating of the domain name system on the Internet network. Note that the term "can be viewed" is optional language and has no patentable weight.

As for dep. claims 9, 12-13 (part of 1 above), which deals with well known payment parameters, i.e. electronically or manually, these are inherently included in the registration over the Internet as taught in AAPA. Alternatively, the manual payment of fee by mail or other would have been obvious because this is well known practice.

As for independent method claim 14, which appear to be dealt with updating and maintaining a list of domain name registration for the same maintenance purpose as indicated in independent method claim 1 above, in view of the general teachings of maintaining and updating the domain name of many business entities as taught by BURSTEIN ET AL on cols. 5-8, and 10-12 and KORITZINSKY et al Figs. 14-15 and

Art Unit: 3689

cols. 21-23, it would have been obvious to apply these teachings for effectively monitoring and maintenance (management) of these domain names.

As for claims 16-18, which appear to be dealt with updating and maintaining a list of domain name registration for the same maintenance purpose as indicated in independent method claim 1 above, in view of the general teachings of maintaining and updating the domain name of many business entities as taught by BURSTEIN ET AL on cols. 5-8, and 10-12 and KORITZINSKY et al Figs. 14-15 and cols. 21-23, it would have been obvious to apply these teachings for effectively monitoring and maintenance (management) of these domain names.

As for independent method claim 19, which appear to be have similar scopes like independent method claim 1 above, it's rejected for the same reason set forth in the rejection of claim 1 above. The various adjustment of the use of the domain name system is within the skilled artisan and would have been obvious.

As for claims 23-24, which appear to be dealt with updating and maintaining a list of domain name registration for the same maintenance purpose as indicated in independent method claim 1 above, in view of the general teachings of maintaining and updating the domain name of many business entities as taught by BURSTEIN ET AL on cols. 5-8, and 10-12 and KORITZINSKY et al Figs. 14-15 and cols. 21-23, it would have been obvious to apply these teachings for effectively monitoring and maintenance (management) of these domain names.

14. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over BURSTEIN et al /Domain Name Registration.com and/or KORITZINSKY et al as applied to claims 1-3, 9, 12-13 above, and further in view of CUMMINGS et al.

In a similar business environment for providing financial protection of equity asset, CUMMINGS et al discloses the use of an "equity protection insurance policy (EPIC)" to protect the equity asset/investment in a business entity based on the happening a fortuitous (accidental) event and protects the wealth of the equity owner (investor) in the entity or insure the equity owners the safety of their investment/asset {see abstract, col. 2, lines 1-19, col. 3, line 65 to col. 4, line 50, Figs. 2 and 4}. It would have been obvious to modify the teachings of BURSTEIN et al /Domain Name Registration.com and/or KORITZINSKY et al to include an EPIC to protect the domain name which is a the "a significant asset" as mentioned by BURSTEIN et al above and issue the policy along with the registration receipt/certificate to protect the equity asset/investment in a business entity based on the happening a fortuitous (accidental) event such as failing to renew subscription service as taught in BURSTEIN et al or KORITZINSKY et al and protects the wealth of the equity owner (investor) in the entity or insure the equity owners the safety of their investment/asset.

Art Unit: 3689

15. Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over BURSTEIN ET AL /Domain Name Registration.com and/or KORITZINSKY et al as applied to claims 1-3, 9, 12-13, above, and further in view of MANN et al and CUMMINGS et al .

As for dep. claims 4-5 (part of 1 above), the teachings of BURSTEIN ET AL /Domain Name Registration.com and/or KORITZINSKY et al is cited above. MANN et al, as shown on col. 2, lines 4-18, is cited to disclose well known facts that many domain names have been registered by sellers/brokers as assets (equity) which may be sold for large sums of money for acquiring or transferring and using of the domain names to point to their content sources.

CUMMINGS et al is cited to teach well known business practice of obtaining insurance policy and title for an equity /asset to cover financial losses associated with the equity, thus protecting the equity/asset investment in case of losses {see col. 1, lines 15-20, claim 1}. It would have been obvious to modify the teachings of BURSTEIN ET AL /Domain Name Registration.com and/or KORITZINSKY et al by obtaining insurance policy and title as taught by CUMMINGS et al for the domain name registration to protect the domain names since MANN et al discloses that domain names are valuable assets/equity that can be sold for large sums of money.

16. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over BURSTEIN ET AL /Domain Name Registration.com and/or KORITZINSKY et al as applied to claims 1-3, 9, 12-13, above, and further in view of MAPLES ET AL.

Art Unit: 3689

As for dep. claim 6 (part of 1 above), the teachings of BURSTEIN ET AL /Domain Name Registration.com and/or KORITZINSKY et al is cited above. MAPLES ET AL is cited to disclose well known business operation facts that a business entity or company raises money for company operations and not go into debt to do so by issuing shares for sale and reward the shareowners who profit when the shares increase in price {see col. 1, lines 20-65}. It would have been obvious to modify the teachings of BURSTEIN ET AL/Domain Name Registration.com and /or KORITZINSKY et al by issuing shares with the certificate to raise money for company operations and not go into debt to do so by issuing shares for sale and reward the shareowners who profit when the shares increase in price as taught by MAPLES ET AL above.

17. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over BURSTEIN ET AL /Domain Name Registration.com and/or KORITZINSKY et al as applied to claims 1-3, 9, 12-13, above, and further in view of ELLIOTT.

As for dep. claims 7-8 (part of 1 above), the teachings of BURSTEIN ET AL /Domain Name Registration.com and/or KORITZINSKY et al is cited above. ELLIOTT is cited to disclose well known method for allocating investment based on the capitalization of company/business asset (i.e. intellectual property (IP)) by issuing leases, licensing, etc., for increasing capital which may be employed to perpetuate further useful enterprises {see Figs. A, C, col. 1, lines 15-25 and col. 2, lines 19-62, col. 3, lines 1-55}. It would have been obvious to modify the teachings of BURSTEIN ET AL/Domain Name Registration.com and /or KORITZINSKY et al by issuing leases or

Art Unit: 3689

sub-leases and co-ownership certificates as taught by ELLIOTT for increasing capital which may be employed to perpetuate further useful enterprises.

Note also that the phrase "allow ownership interest to be reserved" basically reads "allows a task to be carried out". In other word, "allowing an action" is different from actually "performing the action". "allowing" or "permitting" only requires serving as the reason for an action though, not necessarily performing the action. This can be done by issuing commands or orders, or entering into contracts. So even though the entity may do something later with the equipment that is in the technological arts, the positively recited steps of merely "causing" can be done without operating the equipment and is not in the technological arts. Variations on this theme have been seen in other cases, using terms like "allowing" or "permitting" an action, e.g. "allowing a user to search a database". Again, these steps are distinct from actually doing the action, e.g. searching.

18. Claims 10-11 and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over BURSTEIN ET AL /Domain Name Registration.com and/or KORITZINSKY et al as applied to claims 1-3, 9, 12-13, and 19-22 above, and further in view of Perpetual Bond Article (Dictionary of Finance and Investment Terms, 1998, "PERPETUAL BOND" definition", page 445).

As for dep. claims 10-11 and 21-22 (part of 1 above), the teachings of BURSTEIN ET AL /Domain Name Registration.com and/or KORITZINSKY et al is cited above.

Art Unit: 3689

Perpetual Bond Article is cited to teach a financial instrument whose profits or interest is generated perpetually or has no maturity data, is not redeemable and pays a steady stream of interest indefinitely, also called annuity bond. {see page 445}. It would have been obvious to modify the teachings of BURSTEIN ET AL/Domain Name Registration.com and /or KORITZINSKY et al by linking the payment to a financial instrument whose profits or interest is generated perpetually or has no maturity data, is not redeemable and pays a steady stream of interest indefinitely, also called annuity bond as taught by Perpetual Bond Article to provide a steady stream of interest payment that is generated perpetually or indefinitely for the payment of the fee if desired. The term annuity bond reads over claim 10.

19. Note: In claim 10, step (a), the phrase "...to perpetually pay ...registration" is not a positively recited method step but, rather, is mere intended use of the profits or interest and thus having no patentable weight. See MPEP 2173.05 (q), 2106, and 2111.04, which indicate that a method claim requires active, positive steps.

Response to Arguments

20. Applicant's arguments with respect to claims 1-33 have been considered but are moot in view of the new ground(s) of rejection and not persuasive in view of the following:

In response to applicant's argument that AAPA and KORITZINSKY et al is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, In view of the general problems with respect to the expired subscribed service for the domain name registration as mentioned in the AAPA , it would have been obvious to modify the yearly/annual fee payment teachings of AAPA with a permanent fee payment as taught by KORITZINSKY et al to obtain the benefit of lifetime or non-expiring warranty service. Note that the type of subscription service in KORITZINSKY et al deals with subscribing to diagnostic system/service, however, the type of service or subscription service is not critical since fee payment arrangement can be applied in any subscription service. Moreover, the critical issue is "fee payment option" and facing with the problem of expiring of service due to non-payment, a skilled artisan would look to the teachings of fee payment options or different levels of service and if the service is so critical while the fee payment is so cheap, one would pick the permanent or lifetime or non-expiring warranty service to insure lifetime service.

Art Unit: 3689

As for the difference in the type of subscription services, again, this is not critical and within the skill of the artisan since the major issue is the types of fee payment options for different levels of service and subscription to diagnostic service is one of many teachings cited by KORITZINSKY et al.

As for the limitation of "wherein the one-time permanent registration fee is used to perpetually pay all future renewal fees for the domain name registration", this reads over the limitation "lifetime or non-expiring warranty service" of KORITZINSKY et al and is therefore inherently included in the teachings of KORITZINSKY et al above.

21. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). KORITZINSKY et al is merely cited to teach the concept of updating, verifying, maintaining and fee payment types/levels for a subscription service.

Art Unit: 3689

22. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail CustomerService3600@uspto.gov.

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday. Should I be unavailable during my normal working hours, my supervisor Janice Mooneyham can be reached at (571) 272-6805. The main FAX phone numbers for formal communications concerning this application are (571) 273-8300. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

/Tan Dean D. Nguyen/
Primary Examiner, Art Unit 3689